

Remarks

1) Claims 3 – 46 were pending in the case. By the Office Action mailed October 18, 2002, a formal rejection under 35 USC 112 was made against claim 4. The Examiner made further rejections under 35 USC 102 of claims 3, 7 and 12 in light of Johnson '153 and claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 in light of Black, Jr., et al. Further rejections under 35 USC 103 of claims 4-7 were made in light of Johnson '153 in view of Russel; claim 8 was rejected in light of Black, Jr., et al., in view of Bell et al. '426; and claims 12, 18 and 28 were rejected in light of Black, Jr., et al., in view of Thompson '478.

In the Detailed Action, the Drawings were objected to for failing to show all features identified in the specification and claims.

The Examiner indicated that claims 8, 11, 16, 17, 19, 21, 22 and 27 would be allowable if rewritten in independent form.

2) Office Action Contradictory

The office action of October 18, 2002 is confusing for the following reasons:

The Drawings

Page 2 of the Detailed Office Action indicates that the drawings are objected to. The Office Action Summary however, fails to indicate that the drawings are objected to. Applicant requests clarification in this matter.

Claim 8

The Office Action Summary indicates that claim 8 is objected to. Furthermore, on page 6 of the Detailed Action, the Examiner indicates that claim 8 would be allowable if rewritten in independent form to include all the limitations of the base claim and intervening claim. However, on page 5 of the Detailed Action, the Examiner states that claim 8 is rejected under 35 USC 103(a) as being unpatentable over Black, Jr., et al, '187 in view of Bell et al. '426. Applicant requests clarification as to the allowability of claim 8.

Request for New Office Action

In the event that the Examiner refuses to pass this case to allowance, the applicant respectfully requests a revised non-final office action, with the full provision of time in which to respond under the statute, namely **6 months** measured from the date on which such action is sent to the applicant, in which the objections of the Examiner are unambiguously stated.

3) 35 USC 1.83 (a) – Objection to Drawings

The Examiner has objected to the drawings for failing to show items 172 and 173 to be a pair of aligned holes, as indicated on page 20, line 17. This feature is indicated in Figure 4a which shows a top view of the bridge plate. The circumference of the aligned holes are indicated as items 172 and 173. The drawing has been amended to show the circumference of the hole in sheet 152 as item 172 and the circumference of the hole in plate 162 as item 173. Note that the aligned holes 172 and 173 have been indicated in this manner in Figure 4a for the purposes of clarity.

The Examiner states that claim 19 refers to a plastic pad mounted to the bottom flange of the bridge plate but that this feature is not indicated in the drawings. Applicant submits that this feature is presently shown in Figure 4b, as item 211. In addition, this feature is indicated in Figures 4c, 4d and 4e as item 211. The applicant respectfully submits that no further amendment to the drawings is required at this time.

4) 35 USC 112 – Formal Objections

Claim 4

The Examiner has again objected to the wording “the set of fittings” as lacking proper antecedent basis. The applicant again respectfully traverses the Examiner’s rejection. The wording used by the applicant in claim 4 has the classic form of a *Markush* claim sanctioned by the USPTO. (*Ex parte Markush* [1925] C. D. 126; O.G. 839).

The Examiner has now thrice objected to a form of claim drafting that has been accepted practice in the USPTO for nearly 80 years. In that light, the applicant respectfully requests that the Examiner re-acquaint himself with proper practice for drafting Markush claims. The applicant commends to the Examiner s. 57 of the text *Landis on Mechanics of Patent Claim Drafting*, by

Robert C. Faber, published by the Practicing Law Institute. Further commentary on this subject may be found in Chapter 8.06[2][a] in the text of *Chisum on Patents*. The Examiner is specifically referred to pages 8-223 to 8-224, which state:

“Decisions by the Court of Customs and Patent appeals cast doubt on the propriety of rejecting claims solely on the basis of the form of language used. Rejections must be based on specific statutory provisions. The second paragraph of Section 112 dealing with claims requires only that claims be precise and definite in scope. The use of alternatives does not necessarily render the scope of a claim indefinite.”

and further, on page 8-227,

“Decisions of the Court of Customs and Patent Appeals suggested that a prohibition of alternative language in claims cannot be justified on the basis of the definiteness requirement of the second paragraph of Section 112, even when the two alternatives are not equivalent.”

In the event that the Examiner is unwilling to acknowledge that this rejection under 35 USC 112 has been made in error, the applicant respectfully requests (a) that the Examiner identify, with precision, the statutory provision, regulation, or caselaw upon which the rejection is founded; and (b) that the Examiner identify, according to standard rules of English grammar, with reference to the syntax of the claim as presently drafted, the grammatical error in the claim that forms the root cause of the Examiner’s rejection.

If the Examiner can identify, with precision, a grammatical or syntactical error in the claim, the applicant will gladly amend the claim to overcome that error.

Similarly, the Examiner’s objections under 35 USC 112 concerning the collar and the pivot pin do not appear to be properly made since one integer of a set in a *Markush* claim, by definition, does not provide antecedent basis for any other integer in the set. In that light, the applicant submits that the Examiner’s rejection on this ground is inconsistent with the long accepted practice of the USPTO. Moreover, since the pivot pin referred to in claim 4, line 4 is unrelated to the pivot pin referred to in line 3, the Applicant rejects the Examiner’s suggestion to replace the word “a” with - the- in line 4. Similarly, since the collar referred to in claim 4, line 4 is unrelated to the collar referred to in line 3, the Applicant rejects the Examiner’s suggestion to replace the word “a” with -

the- in line 4. The applicant respectfully requests withdrawal of the current rejection of claim 4 under 35 USC 112.

5) Rejections Under 35 U.S.C. 102 - Anticipation

(i) Test for Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

(ii) U.S. Patent 3,161,153 of Johnson

Johnson Expressly Distinguishes Invention

Johnson '153 clearly does not have the features of claims 3, 7 and 12. Claim 3 pertains to a bridge plate that is capable of staying in position spanning the gap between adjacently coupled rail road cars while the train is in motion. The rejection currently made to claims 3, 7 and 12, relies upon only partial analysis of the presently pending claims. By ignoring the capability to accommodate yaw while the train is in motion, for example, the Examiner has failed to meet the test for anticipation as required by law since Johnson cannot then be "found in exactly the same situation", "united in the same way", to "perform the same function" as required in *Kohle v. Dart* (cited above).

Johnson '153 teaches away from the presently claimed invention (col. 1, ln.59-col. 2, ln. 2):

"Also, if the plates were left in operative position they would interfere with railroad personnel in operating the couplings between cars and would frequently be caught between the ends of adjacent cars and damaged while the train of cars was negotiating railway curves. The bridging plates thus had to be mounted in a suitable manner, as by hinges, for freedom of vertical movement of the free ends of the plates. In addition to having the free or

distal end vertically movable, the plates also had to be movable between an operative position in which they would span the corresponding gaps between adjacent car ends and *an inoperative position in which they are out of the way of railroad operating personnel, and in which they cannot be caught between adjacent car ends or [on ?] curves and damaged.*" (Emphasis added).

The central point of Johnson's invention is that it permits motion of the bridge plate to the inoperative position without the degree of lifting associated with raising and lowering draw-bridge style bridge plates. The inoperative position is the position employed when the train is rolling along the rails. There is no suggestion that Johnson's bridge plates are deployed during train operation, quite the contrary.

Given that this is Johnson's invention, and given Johnson's disclosure, not only does Johnson '153 not anticipate claim 3, or any other claim presently pending in the case, but rather, Johnson '153 teaches away from the present invention, the applicant submits that no grounds have been established for a rejection under 35 USC 102.

The applicant therefore requests that the rejection under 35 USC 102 be withdrawn, and claim 3 allowed, and that dependent claims 7 and 12, rejected on the same basis, now also be allowed.

In the event that the Examiner proposes to sustain the present rejection of any of claims 3, 7 or 12 under 35 USC 102, the Examiner is respectfully requested to follow the procedure of *Ex Parte Rozzi* 63 USPQ (2d) 1196 (Bd. Pat. App. & Int. 2002) and *Ex Parte Braeken* 54 USPQ (2d) 1110 (Bd. Pat. App. & Int 1999), and to provide a detailed, reasoned explanation of how a reference that clearly teaches away from the invention, in this instance US Patent 3,161,153 of Johnson can anticipate the claimed invention.

iii) US Patent 5,782,187 of Black, Jr.
Black Expressly Distinguishes Invention

The Examiner has rejected claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 as being anticipated by Black, Jr., et al. Applicant notes that in the Office Action of February 21, 2002, claims 9-10, 13-15, 20, 23-26 and 29-32 were rejected under 35 USC 103(a) as being unpatentable over Johnson in view of Black, Jr., et al., and Bell et al. Presumably, the Examiner has retracted this rejection in favour of a rejection of the same claims under 35 USC 102(b) in light of the Black, Jr., et al., reference taken alone.

The example cited by the Examiner in Black, Jr., shows permanently mounted bridge plates located between two car units of an articulated rail road car. This is not the same as the present invention at all. The aspects of the invention presently claimed relate to a bridge plate for use at the coupled end of a rail road car, to span the gap between vehicle decks at the couplers. As explained in the background of the invention at page 4, lines 21 – 34, the internal bridge plates mounted at a permanent articulated connector of an articulated rail road car face quite different design criteria and operating requirements than bridge plates at the coupler ends.

Figures 1-8 of Black, Jr., cited by the Examiner, show an internal bridge plate. They do not reveal anything about the coupler end bridge plates. The Abstract makes no reference whatsoever to coupler end bridge plates. Indeed, the Abstract makes it abundantly clear that the bridge plates cited by the Examiner are “over the articulation between interconnected railway car units”. The Examiner has not identified where in the vast amount of text in col. 1 – 2 lines 1 - 67 there is support for the Examiner’s position. However, Black, Jr. repeatedly states that the bridge plates are between pivotally interconnected units, supporting the argument presented by the applicant.

In this regard, the applicant specifically notes that the Examiner’s description in the Examiner’s report mailed October 18, 2002 is incorrect in stating that Black, Jr., shows “... a beam 32 locatable in a longitudinal orientation of sufficient length to span a gap between a pair of adjacent railroad cars (22a, 22b), ...” Items **22a** and **22b** are not adjacent rail road cars. On the contrary, car units **22a** and **22b** are units of a single articulated rail road car, **22** as plainly indicated by Black, Jr., at, for example, col. 4, lines 1-7. The Examiner’s attention is also drawn to Figures 1 and 2 of Black, Jr., which show a single railway truck supporting the two interconnected units **22a** and **22b**.

In the context of claims 13 and 20, this fundamental conceptual difference is emphasized not only by the intended use between two releasably coupled rail road cars, but further by indicating that one of the fittings is disengageable. The Examiner contends that the bridge plate of Black, Jr. contains a pivot pin which is disengageable “if proper tooling is available”. This conjecture is made without any support in the art of record in this matter. Clearly, the Black, Jr., bridge plate is not intended to be disengageable, but appears to be intended as a permanent element of the car. That is, not only is plate 32 retained by items **102a** and **102b**, (see Figure 8) but the entire plate is sandwiched between the permanently mounted movable platforms **30a** (or **30b**) and the underlying structure of the body of the car unit, be it **22a** or **22b** (See Figure 2). It is not surprising that plates 32 should be permanent – they are located at the permanent connection at the articulated connector. Furthermore, there is no reference in Black, Jr. to either of the plates being disengaged from the car.

Similarly, in claim 3, the intended use of the bridge plate between a pair of first and second rail road cars and the potential movement of the beam from a longitudinal orientation to a cross-wise orientation when the beam is disengaged from the second rail road car, emphasizes this fundamental difference.

Similarly, again, in the context of claim 24, again, Black's bridge plates are not used at the coupler ends of the car. As such, the Black does not have a disengageable pivot pin, but rather connections that appear to be intended to be permanent mountings. Consequently, the applicant submits that Black, Jr., et al., do not meet the test for anticipation noted above with respect to any claim presently pending in the case. The applicant submits that no grounds have been established for a rejection under 35 USC 102 and requests that the rejection be withdrawn.

6) Claim Rejections Under 35 U.S.C. 103 – Obviousness - Law

(a) MPEP Section 2142: Basic Requirements of a *Prima Facie* Case of Obviousness

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir 1991).

(b) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

(c) Must Have Teaching, Suggestion, or Incentive to Combine

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.). Cited in *In re Geiger*, 815 F.2d at 688, 2 USPQ 2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 USPQ 2d 1430 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee, infra* ; see also *Ex Parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) Inquiry Must Present a Convincing Line of Reasoning

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

...

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)."'

(e) Inquiry Must Be Thorough And Searching

"The factual enquiry whether to combine the references must be thorough and searching. Id., It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

"The need for specificity pervades this authority. See e.g.,

"*In re Kotzab* 217 F. 3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no

knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”);

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”);

In re Fritch, 972 F. 2d 1260, 1265, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”.)

(*In re Lee*, 61 USPQ 2d 1430 (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*).

(f) “Would have been obvious to one skilled in the art”

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination “would have been obvious to one skilled in the art” is improper if made without support. *In re Lee, supra*, and *In re Garrett* 33 BNA PTCJ 43.

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

(g) Destruction of Function

“If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation

to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

7) The Cited References

The Examiner has rejected claims 4-7 as being unpatentable over Johnson '153 in view of Russel.

Commentary re: US Patent 2,788,751 of Russel

The invention of Russel provides a bridge for spanning the gap between adjacent flat cars which may be stored in a horizontal position in order to reduce the potential for injury that resides in bridges that are normally required to be lifted to a vertical position for storage during transit. In column 2, lines 36-39, Russel states:

"The present invention provides a bridge which is slidably mounted on the substructure of a piggyback flat car for movement between a transit position and a loading position. In the transit position, the bridge overlies the bed of the flat car, and in the loading position, the bridge rests at one end on the bed of the adjacent flat car..."

Clearly then, in the invention of Russel, the loading position is different from the transit position in which the bridge is completely supported by a single car. There is no indication that the bridge is designed to remain in position to bridge the gap between adjacent rail road cars during transit. On the contrary, the very use of the terminology "transit position" to designate the non-spanning condition appears strongly to suggest the contrary. In fact, while the fitting of Russel permits motion of the bridge plate between the transit position and the loading position, it in no way permits yawing of the plate relative to the first railroad car when the rail cars are in motion, since the bridge is not designed to span the gap between adjacent cars during transit.

Re: Incentive to Combine Johnson '153 and Russel

(i) No Suggestion, Motivation or Incentive Demonstrated

The applicant notes that the Examiner has failed to identify any feature in any of the cited references from which a person skilled in the art would infer a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of any of claims 4-7. As such no *prima facie* ground for rejection has been established under 35 USC 103. On that ground

alone the applicant respectfully requests withdrawal of the current rejection of claims 4-7.

(ii) Combination of US Patent 3,161,153 and US Patent 2,788,751
Both References Teach Away From the Claimed Invention

Given that, as discussed above in the context of rejections made under 35 USC 102, Johnson '153 teaches away from the claimed invention of claim 3 and claims 4-7 which depend therefrom, there can be no motivation, suggestion, or incentive to employ Johnson in any way to arrive at the presently claimed invention of dependent claims 4-7 .

All of the current rejections under 35 USC 103 employ Johnson as the primary reference. Since Johnson '153 expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that no rejection under 35 USC 103 can be supported by Johnson '153.

Furthermore, as discussed above, Russel also teaches away from leaving the bridge plates in place during train operation. Further still, while the pivot pins of Russel permit motion of the bridge plate, this is not the motion required to permit yawing of the bridge plate relative to the railroad car. This being the case, the Examiner has neither established that the proposed combination is suggested in the art nor that it would include all the features of the claim. Consequently, the applicant submits that *prima facie* grounds for rejection under 35 USC 103 have not been established and requests that the rejection be withdrawn and the claims allowed.

Commentary re: Combination of US Patent 5,782,187 of Black, Jr. and
US Patent 4,721,426 of Bell

The Examiner has rejected claim 8 as being unpatentable over Black, Jr. in view of Bell et al. According to the Examiner, Black, Jr. shows all the limitations of claim 8 except for the railroad car bridge plate having a surface with traction bars mounted thereto.

(iii) Commentary re: US Patent 4,721,426 of Bell
Reasoning in Office Action is Based on Mistaken Premise

The Examiner has cited the Bell reference thusly:

"Also, the general concept of using traction bars on the top surface of an aluminum bridge plate assembly of two railroad car units is well known in the art as illustrated by Bell et al, see fig. 1, column 1, lines 60 –67, column 2, lines 49 – 51."

and further,

"It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Black, Jr., et al., to include the use of traction bars on the top surface of an Aluminum bridge plate assembly in his advantageous bridge plate as taught by Bell et al., ..."

The Examiner's statements founder on the fundamental factual problem that the Bell reference does not show traction bars.

- (a) The first location cited by the Examiner is Fig. 1. Figure 1 shows a top view of a relatively conventional channel. There are no tread bars shown in this view.
- (b) The second location cited by the Examiner is column 1, lines 60 – 67. They read as follows:

Referring to FIG. 3, the cross-section of the plate between the hinged end and the tapered dock end includes several trusses partly responsible for being able to construct the plate entirely of aluminum and of minimum thickness at that."

There are no tread bars referred to in this quotation.

- (c) The third location cited by the Examiner is column 2, lines 49 – 51. Column 2, lines 49 – 51 read as follows:

"The brace plate should also maintain a flat dimensional integrity for tread surface 12. This construction ..."

There is no mention of tread bars here either. On the contrary, the reference to tread surface 12 is to the upper smooth surface of the plate upon which wheeled vehicle can roll, and which lies flat. There are no tread bars mounted to surface 12.

In conclusion, the cited Bell reference simply does not show the features alleged by the Examiner, and upon which the rejection relies. To the extent that this rejection is founded on a false premise, the applicant respectfully submits that no basis for a *prima facie* rejection under 35 USC

103 has been established. Therefore the applicant respectfully requests withdrawal of the rejection and allowance of the claim so rejected.

(iv) No Suggestion, Motivation or Incentive Demonstrated

The applicant notes that the Examiner has failed to identify any feature in any of the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of claim 8. As such no *prima facie* ground for rejection has been established under 35 USC 103. That ground alone is sufficient basis for the applicant respectfully to request withdrawal of the current rejection of claim 8.

Commentary re: Combination of US Patent 5,782,187 and US Patent 3,195,478

The Examiner has cited the combination of Black, Jr., et al., and Thompson against claims 12, 18 and 28. According to the Examiner, Black, Jr. teaches all of the limitations of claims 12, 18 and 28 except for a handgrab mounted to a railroad car bridge plate. The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the bridge plate of Black, Jr., et al., to include the use of a handgrab as taught by Thompson.

Commentary on Thompson '478

The bridge construction of Thompson is clearly not designed to remain in a position spanning two railroad cars during transit. In column 2, lines 19-21, Thompson states:

“...which bridge plate and which bridge plate supports are adapted to be swung from a loading position to a transit position.”

Further, as illustrated in Figure 3 and described at column 3 lines 45- 50,

“which bridge plate is pivotally mounted...for swinging movement between a generally horizontal loading position and a generally vertical transit position.”

The purpose of the handgrab in Thompson is to facilitate the movement of the bridge plate between the horizontal loading position and the vertical transit position.

(v) No suggestion Motivation or Incentive Demonstrated

The applicant notes that the Examiner has failed to identify any feature in any of the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of any of claims 12, 18 and 28. As such no *prima facie* ground for rejection has been established under 35 USC 103. On that ground alone, if no other, the applicant respectfully submits that it is entitled to request withdrawal of the current rejection of claims 12, 18 and 28.

(vi) Black, Jr. Teaches Against the Invention

Given that, as discussed above in the context of rejections made under 35 USC 102, Black, Jr. teaches away from the claimed invention of claims 3, 13 and 24, there can be no motivation, suggestion, or incentive to employ Black, Jr. in any way to arrive at the presently claimed invention of dependent claims 12 , 18 and 28, which depend from claims 3, 13 and 24, respectively.

To the extent that any current rejection under 35 USC 103 employs Black, Jr., as the primary reference, and given that Black, Jr. expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that no rejection under 35 USC 103 is supported by Black, Jr.

(vii) Black, Jr. and Thompson: References Teach in Opposite Directions-
No Motivation to Combine

Since the bridge plates of Black, Jr. are intended to be mounted permanently to span the articulated connector between two rail car units, and the handgrabs on the bridge plate of Thompson are intended for use in swinging the plate into a vertical position for transit, it would not be obvious or even desirable to mount a handgrab to the bridge plate of Black, Jr. The Examiner has not pointed to any explanation of why a permanently mounted bridge plate would require a handgrab. The applicant submits that a person of ordinary skill in the art would not be motivated to modify Black, Jr., to include the use of a handgrab as is suggested by the Examiner, since this modification would not appear to provide any advantage whatsoever to the Black, Jr. apparatus.

Since the cited references therefore teach in opposite directions, the applicant contends that no motivation to combine these two references can be found. As such, applicant submits that no basis for a *prima facie* rejection under 35 USC 103 has been established. Therefore the applicant respectfully requests withdrawal of the rejection and allowance of the claims so rejected.

8) Office Action Unresponsive to Previous Replies

The Examiner has a duty under MPEP 707.07(f) to respond in a thorough and considered manner to arguments raised by the applicant. The applicant respectfully submits that the Examiner has failed to discharge his duty in this regard.

The Examiner states: "Applicant's arguments filed 08/26/02 [i.e., August 26, 2002] have been fully considered but they are moot in view of the new grounds of rejection and the allowance of claims 33 - 46."

This statement is, in part, simply incorrect, and in part contradicted by the actual substance of the current rejections.

a) Examiner has Asserted Identical Grounds Under 35 USC 112

The Examiner has asserted the same grounds for rejection of claim 4 as formerly asserted. The applicant previously addressed this rejection at length (and has repeated the same arguments, again, above). The thrust of the applicant's argument then, (and now), is that there is no basis in law or in grammar for the rejection of claim 4 under 35 USC 112, that the Examiner's position contradicts almost 80 years of caselaw, and that the applicant's position was long ago accepted by the USPTO. The office action of October 18, 2002 makes no reply to the arguments presented by the applicant. Specifically, the Examiner makes no explanation of how, or why, he has departed from what has been accepted patent law in the United States for almost 80 years.

Thus, the applicant respectfully submits that, for this reason if no other, the above quoted statement from the Office Action of October 18, 2002 is necessarily in error, at least in part.

In any case, the applicant again requests that either the Examiner demonstrate a basis in law for the rejection of claim 4 under 35 USC 112, or acknowledge that the rejection is without basis in law, and withdraw the rejection accordingly.

b) Substance of Rejections Under 35 USC 102 Remains the Same

The Examiner has now again rejected claims 3, 7 and 12 under 35 USC 102(b) as being anticipated by U.S. Patent 3,161,153 of Johnson. This is the very same rejection, on the basis of the same art as previously. The applicant respectfully submits that, by any reasonable standard, it defies comprehension how this further rejection, on the same grounds, can possibly be characterized as "new grounds for rejection".

The substance of the rejection is the same as was made before, and the rejection is ill founded for the very same reasons it was ill founded before. The Examiner has neither at any point nor by any means addressed the arguments previously put forth by the applicant. Those arguments are as pertinent to the rejections as they presently stand as they formerly were. To the extent that they stand uncontroverted by the Examiner, the applicant respectfully submits that it is entitled to allowance of those claims.

c) Substance of Rejections Based on Black, Jr. Remains the Same

The Examiner formerly rejected claims 8 – 10, 12 – 15, 17 – 18, 20 – 21, 23 – 26, 28 – 37, 39- 42, and 44 – 46 on the basis of US Patent 3,161,153 in light of US Patent 5,782,187 of Black, Jr.

The Examiner now rejects claims 3 – 7, 9 – 10, 13 – 15, 20, 23, 24 – 26, and 29 – 32 under 35 USC 102(b) as being anticipated by Black, Jr., et al.

The very same arguments presented by the applicant at pages 11 – 12 of the response to office action of August 26, 2002 continue to apply, as noted above. The suggestion that Black's pivot pins are "disengageable if proper tooling is available" is (a) utterly unsupported by any evidence of record in this case; (b) without any support whatsoever for the existence of any suggestion, motivation, or incentive in any art of record in this case; (c) insufficient to found a rejection under 35 USC 102 in any case, since the current rejection requires the addition of information clearly not found in the purportedly anticipatory reference (namely, that the pivot pins are "disengageable if proper tooling is available"); and (d) insufficient to found a rejection

under 35 USC 102 in any case, because the Black, Jr., et al., reference does not meet the required test, as explained above.

In this regard, the Examiner has not addressed any of the points previously raised in argument by the applicant, it being inescapable that for the current rejections under 35 USC 102 to stand, the applicant's previous arguments must still be shown to be incorrect. Yet the Examiner has provided nothing to establish such a conclusion, but rather suggests that, somehow, these arguments are "moot". The applicant respectfully submits that an argument whose position must be proven to be false in order for the current rejections to be sustained is hardly one that a reasonable man could describe as "moot".

d) Unresponsive to Statements of The Law

The previous office actions in this matter contained purported statements of the law that were without foundation in the statute, the regulations, or the caselaw. Indeed, the applicant respectfully submitted that some of the statements were either incomprehensible, or directly contrary to the law. Inasmuch as those points were fundamental to the examining process, the applicant respectfully and explicitly requested specific clarification of those points. No such response has been provided by the Examiner.

The applicant again requests a detailed explanation of the statements of the law formerly made by the Examiner, as indicated in the response to office action of August 26, 2002.

(e) Summary

In summary, for all of the reasons set out in items 8 (a) to 8 (d), the applicant respectfully submits that the Examiner has not discharged his duties under MPEP 707.07 (f).

9) Conclusion

In view of the foregoing arguments, the applicant submits that claims 3 – 32 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

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Respectfully submitted,



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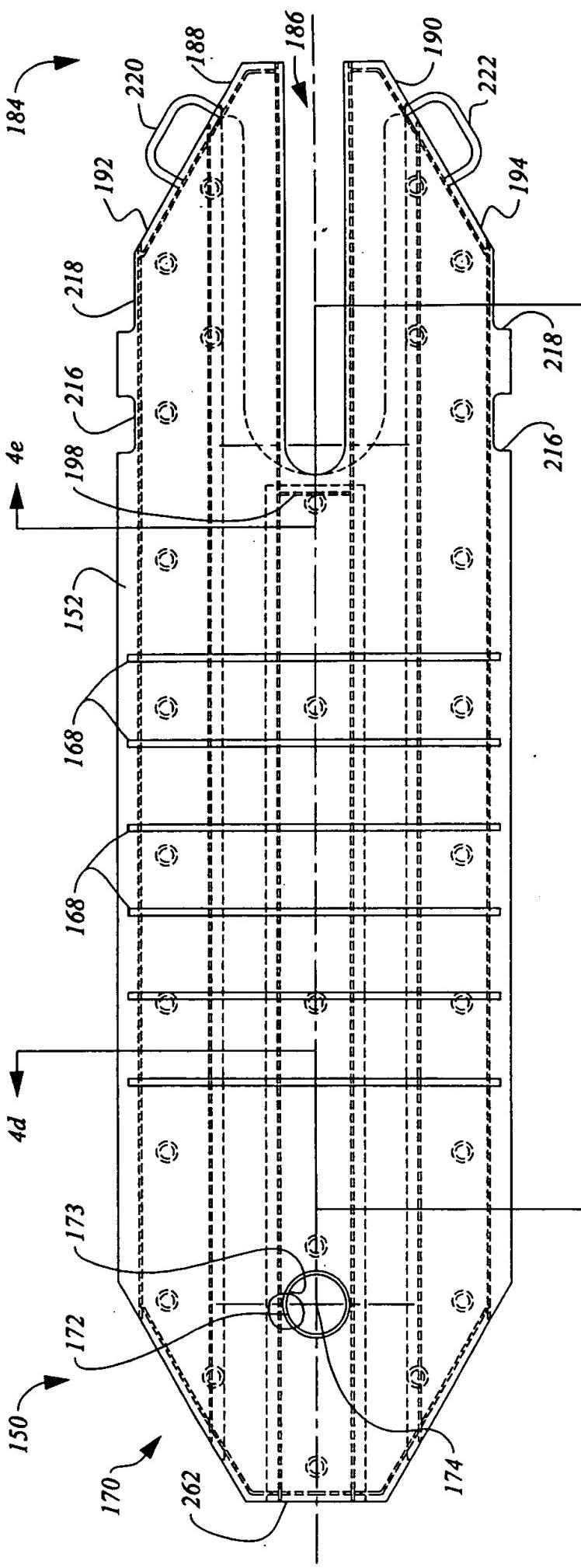


Figure 4a

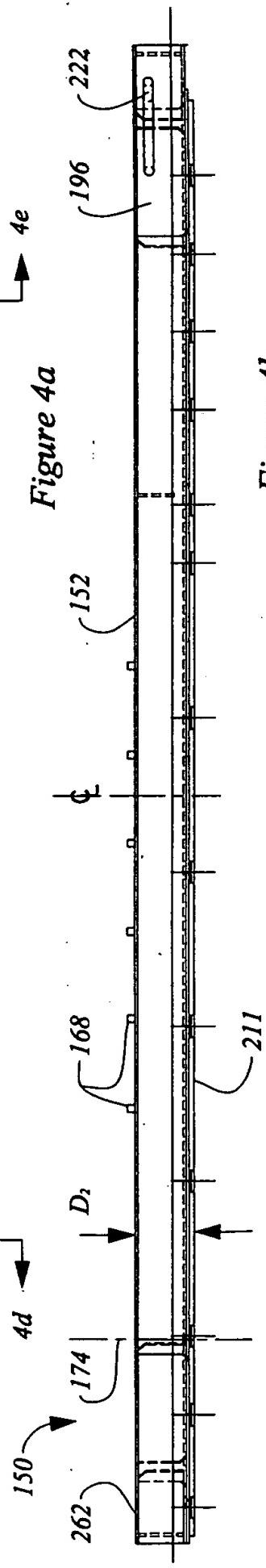


Figure 4b